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CHA & REITER, LLC
210 ROUTE 4 EAST STE 103
PARAMUS, NJ 07652

EXAMINER	
SIDDIQI, MOHAMMAD A	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/804,074
Filing Date: March 13, 2001
Appellant(s): JOHNSON ET AL.

Stephen Gigante (Reg. 42,576)
For Appellant

EXAMINER'S ANSWER

Art Unit: 2100

This is in response to the appeal brief filed 01/31/2008 appealing from the Office action mailed 06/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(**8) Evidence Relied Upon**

6,877,137	Rivtte	4-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Independent claims 17, 41, and 53 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not

tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The web browser, a graphical collaboration tool, and server process are software constructs (software per se) performing various functionalities. These functionalities do not manipulate any hardware or tangible entity. Therefore, these software constructs are non statutory entities as detailed in MPEP 2106.

3. Independent claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The claimed subject matter does not produce useful practical application. Therefore claim 23 is non statutory entities as detailed in MPEP 2106.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims rejected 1-14, 16-65 are under 35 U.S.C. 102(e) as being anticipated by Rivette et al. (6,877,137) (hereinafter Rivette).

6. As per claims 1 and 23, Rivette discloses a computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps (col 7, line 45 to col 8, line-31) of: generating by an originator client workstation (Chef is originator and must be using work station, col 11, lines 17-30) a collaborative content including a base document (recipe is send by e-mail, col 11, lines 17-30) having a document identifier (URL col 11, lines 17-30) that identifies a location of a content (URL col 11, lines 17-30); and at least one collaborative content element (col 11, lines 17-30) at least one annotation therein and rendering instruction therefore so as to annotate said base document by embedding (adds a new note, col 11, lines 17-30) said at least one annotation and

instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution (uses a present invention to send this new sets of notes to other chef, fig 5-7I, col 11, lines 17-30, lines 40-65);

rendering by a server said collaborative content element to said base document in accordance with rendering instruction (fig 5-7I, col 11, lines 17-30, lines 40-65), and providing said collaborative content to said originator client workstation for display fig 5-7I, col 11, lines 17-65).

7. As per claims 2 and 24, Rivette discloses further comprising the steps of: annotating said collaborative content (col 10, lines 6-21) by adding another collaborative content element (new color, col 10, lines 13-21; col 11, lines 17-65).

8. As per claims 3 and 25, Rivette discloses wherein said annotating step comprises presenting annotation options to said client workstation (figs. 5-7I, col 11, lines 17-65).

9. As per claims 4 and 26, Rivette discloses wherein said annotating step comprises inputting a text element to name said collaborative content element ("Customer feedback", figs. 5-7I, col 11, lines 17-65).

10. As per claims 5 and 27, Rivette discloses wherein said annotating steps comprises inputting at least one of a symbol, shape and a text input element to generate text as said collaborative element ("Customer feedback", figs. 5-7I, col 11, lines 17-65).

11. As per claims 6 and 28, Rivette discloses wherein said annotating steps comprises providing a visual cue to indicate the state of said collaborative content (a new color, figs. 5-7I, col 11, lines 17-65).

12. As per claims 7 and 29, Rivette discloses wherein said visual cue comprises at least one of a marker, cursor, icon, and marquee box (figs. 5-7I, col 11, lines 17-65).

13. As per claims 8 and 30, Rivette discloses wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content subsequent to said collaborative content being saved (col 3, lines 38-50; col 11, lines 55-65, Note engine manages notes and it enables user to create, modify and delete).

14. As per claims 9 and 31, Rivette discloses wherein said client workstation includes at least one of a personal computer equipped with internet browser software (col 12, lines 33-49), a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer (figs. 5-7I, col 11, lines 17-65).

15. As per claims 10 and 32, Rivette discloses wherein said client workstation includes a program execution capability comprising: an Interpreted software program (Javascript, col 12, lines 33-49);
a compiled software program (JavaScript, col 12, lines 33-49);
and a software program executed by a virtual machine (JavaScript, col 12, lines 33-49).

16. As per claims 11 and 33, Rivette discloses wherein said transmitting step is performed using a messaging system (e-mail, col 11, lines 17-30).

17. As per claims 12 and 34, Rivette discloses wherein said messaging system includes at least one of:
an electronic mail system (col 11, lines 17-30); an
electronic news or bulletin-board system (col 11, lines 17-30); and a mobile paging system (col 11, lines 17-30).

18. As per claims 13 and 35, Rivette discloses wherein said transmitting step is performed using a transport mechanism including at least one of:
an internet protocol (web, fig 8);
a wireless protocol (web, fig 8);
a synchronous messaging protocol (fig 8); and
an asynchronous messaging protocol (fig 8).

19. As per claims 14, 36, and 37, Rivette discloses wherein said network is a peer-to-peer network, and the rendering step is performed on a server portion of said originator client workstation in said peer-to-peer network (fig 6, col 15, lines 25-46).

20. As per claim 16, Rivette discloses wherein the collaborative content transmitted in said transmitting step includes a URL and rendering instructions (col 11, lines 17-30).

21. As per claim 38, Rivette discloses the collaborative content transmitted includes a URL comprising the embedded annotation and rendering instructions (col 11, lines 17-30).

22. As per claim 39, Rivette discloses wherein said sequences of instructions include at least one of a client-side scripting language (col 12, lines 32-49).

23. As per claim 40, Rivette discloses wherein said sequences of instructions include at least one of Javascript and dynamic HTML (col 12, lines 32-49).

24. As per claim 17, claim is rejected for the same reasons as claim 1, above. In addition, Rivette discloses a web browser software for displaying a collaborative content (browser, figs. 5-7I, col 11, lines 17-65) in accordance with rendering instructions therefor, said collaborative content including a base document (figs. 5-7I, col 11, lines 17-65)

generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element (figs. 5-7I, col 11, lines 17-65).

25. As per claim 18, Rivette discloses wherein said graphical collaboration tool includes a toolbar (fig 43).

26. As per claim 19, Rivette discloses wherein said toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (fig 43).

27. As per claim 20, Rivette discloses wherein said graphical collaboration tool includes a collaborative content element name entry field (fig 43, col 11, lines 17-65).

28. As per claim 21, Rivette discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system (fig 43).

29. As per claim 22, Rivette discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (fig 43 and figs. 5-7I, col 11, lines 17-65).

30. As per claim 41, Rivette discloses graphical collaboration tool is downloaded from a server (fig 43 and figs. 5-7I, col 11, lines 17-65).

31. As per claim 42, Rivette discloses wherein said collaborative content is referencable by a URL (fig 43 and figs. 5-7I, col 11, lines 17-65).

32. As per claim 43, Rivette discloses wherein said graphical collaboration tool includes a client-side scripting language (col 12, lines 33-49).

33. As per claim 44, Rivette discloses wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML (col 12, lines 33-49).

34. As per claim 45, Rivette discloses wherein said collaborative content includes a URL of the base document and a representation of the collaborative content element (col 11, lines 17-30, col 12, lines 33-49).

35. As per claim 46, Rivette discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the added collaborative content element (figs. 5-7I, col 11, lines 17-65).

36. As per claim 47, Rivette discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to modify a collaborative content element, transmits a representation of the

collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element (figs. 5-7I, col 11, lines 17-65).

37. As per claim 48, Rivette discloses wherein said graphical collaboration tool includes a toolbar (fig 43).

38. As per claim 49, Rivette discloses wherein the toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (fig 43).

39. As per claim 50, Rivette discloses wherein the toolbar includes a collaborative content element name entry field (fig 43).

40. As per claim 51, Rivette discloses wherein said collaborative content received from the server includes an HTML page (col 12, lines 33-49).

41. As per claim 52, Rivette discloses wherein said collaborative content received from the server includes an HTML page (col 12, lines 33-49).

42. As per claim 53, the claim is rejected for the same reasons as claim 17, above.

43. As per claim 54, Rivette discloses wherein said collaborative content is referencable by a URL (col 11, lines 17-65).

44. As per claim 55, Rivette discloses wherein said server process is a CGI script (figs. 5-7I, col 11, lines 17-65; col 12, lines 33-49).

45. As per claim 56, Rivette discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (figs. 5-7I, col 11, lines 17-65).

46. As per claim 57, Rivette discloses wherein said server process executes on a client workstation of a user (figs. 5-7I, col 11, lines 17-65).

47. As per claim 58, Rivette discloses wherein said collaborative content transmitted in response to a user request includes an HTML page (col 12, lines 33-49).

48. As per claim 59, Rivette discloses transmitting between said originator client workstation and at least one receiver client workstation a document identifier having said rendering instructions embedded therein and comprising said collaborative content (see discussion of Com Object, fig 7A-7I, col 14, lines 58-67).

49. As per claim 61, Rivette discloses of annotating said collaborative content by adding another collaborative content element by said at least one receiver client workstation (col 7, lines 45-67, col 22, lines 1-15).

50. As per claim 62, Rivette discloses the document identifier comprises a Universal Resource Locator (URI) (col 11, lines 15-40).

51. As per claim 63, Rivette discloses the document identifier comprises a Hypertext Markup Language (col 12, lines 12, lines 33-57).

52. As per claim 64, claim is rejected for the same reasons as claim 63, above.

53. As per claim 65, Rivette discloses adapted for transmitting the collaborative content and rendering instructions therefore between client workstations (elements of fig 5, col 7, lines 45-67, col 8, lines 1-12).

54. As per claim 66, Rivette discloses the client workstations transmit collaborative content and rendering instructions via a server (the limitation is satisfied by using COM compliant application using Object Linking Embedded, and, fig 5, fig 7A-7f, col 7, lines 45-67 and col 8, lines 1-12).

(10) Response to Argument

The rejection to claim 23 and its dependent claims under 35 U.S.C. 101 have been withdrawn. Claiming processor and memory make the claims statutory.

In response to appellant's argument that all of the claims are directed to statutory subject matter (Brief, page 11), The Examiner respect fully disagrees. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. The claimed invention is directed to non-statutory

subject matter. Independent claims 17, 41 and 53 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17, 41, and 53 are directed to software (software per se) not stored on a computer-readable media. The web browser, a graphical collaboration tool, and server process are software constructs (software per se) performing various functionalities. These functionalities do not manipulate any hardware element.

In general, Appellant arguments reflect a difference of opinion over the teachings of the prior art and how these teachings would be evaluated in light of the knowledge generally available to those in the appropriate art and the level of ordinary skill in the art. Moreover, Appellant takes an overly narrow view of the claim language.

Appellant argued Rivette fails to disclose "generating by an originator client workstation a collaborative content including a base document having a document identifier that identifies a location of a content" (brief, P. 19, 25). Examiner disagrees.

Rivette discloses generating (data objects are generated by application and devices, col 8, lines 8-31) by an originator client workstation a collaborative content (notes, col 11, lines 17-30) including a base document

having a document (web page, col 11, line 11) identifier that identifies a location of a content (url, col 11, lines 2-30).

Appellant argued Rivette fails to disclose "and at least one collaborative content element at least one annotation therein and rendering instruction therefore so as to annotate said base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution" (brief, P. 19, 22, 23, 28). Examiner disagrees.

Rivette discloses at least one collaborative content element at least one annotation therein (notes, col 11, lines 17-30) and rendering instruction therefore so as to annotate said base document by embedding said at least one annotation and instructions (Jscript, HTML/DHTML, col 12, lines 33-35) therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution (notes store on network, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26).

Appellant argued Rivette fails to disclose "rendering by a server said collaborative content element to said base document in accordance with rendering instruction" (brief, P. 26, 28). Examiner disagrees.

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Rivette discloses rendering by a server said collaborative content element to said base document in accordance with rendering instruction (notes store on network, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26, please also see , Jscript, HTML/DHTML, col 12, lines 33-35) , and providing said collaborative content to said originator client workstation for display (web page, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 16-24).

Appellant argued Rivette fails to disclose "annotating steps comprises inputting at least one of a symbol, shape and a text input element to generate text as said collaborative element" (Brief, P. 29). Examiner disagrees.

Rivette discloses annotating steps comprises inputting at least one of a symbol (fig 11, col 21, line 13) , shape (col 21, line 13) and a text input element to generate text as said collaborative element new set of notes and sub-notes, col 11, lines 20-21; line 59; col 21, line 13, fig 11, 1102).

Appellant argued Rivette fails to disclose "the server rendering the document, in combination with the collaborative content element (annotation) (Brief, P. 30). Examiner disagrees. It is to be noted Eintracht is

not the prior art.

Rivette discloses server rendering the document in combination with the collaborative content element (notes store on network, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26, please also see, Jscript, HTML/DHTML, col 12, lines 33-35).

Appellant argued Rivette fails to disclose "generating by an originator client workstation of collaborative content elements that comprises at least one annotation and rendering instructions that is forwarded to a server for execution in accordance with the rendering instruction". Examiner disagrees.

As described above, Rivette discloses generating by an originator client workstation (data objects are generated by application and devices, col 8, lines 8-31) of collaborative content elements that comprises at least one annotation and rendering instructions that is forwarded to a server for execution in accordance with the rendering instruction (notes store on network, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26, please also see , Jscript, HTML/DHTML, col 12, lines 33-35).

Appellant argued Rivette fails to disclose "web browser software, said graphical collaboration tool, and said server process execute on the same computer system" (Brief, P. 31). Examiner disagrees.

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Rivette discloses web browser software (internet explorer, col 12, line 42), said graphical collaboration tool (col 22, lines 33-49), and said server process execute on the same computer system (some they can store locally, col 11, lines 24-26, col 15, lines 20-30, in the peer-peer architecture all computers can be server or a client).

Appellant argued Rivette fails to disclose "a processor which, when executed by the processor causes the processor to generate a collaborative content including a base document having a document identifier that identifies a location of a content of the base document, and at least one collaborative content element having an embedded annotation in said document identifier and rendering instructions therefore to render the collaborative content in accordance with the rendering instructions". Examiner disagrees and would like to point to the response to the arguments as set forth above.

Appellant argued Rivette fails to disclose "embedded annotation" (Brief, P, 32). Examiner disagrees and would like to point to the response to the arguments as set forth above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., combining into a single URL with embedded notations and rendering instructions [Brief P. 34) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argued Rivette fails to disclose "a server system for network collaboration comprising a collaborative content including a base document having a document identifier that identifies a location of a content of the base document and at least one collaborative content element having a first embedded annotation to the document identifier as an encoded representation of the collaborative content, and first rendering instructions" (Brief, P. 35). Examiner disagrees.

Rivette discloses a server system for network collaboration (Web Annotation system , 502, fig 10) comprising a collaborative content (note, 1014, fig 10) including a base document having a document identifier that identifies a location of a content of the base document and at least one collaborative content element having a first embedded annotation (1014A,

fig 10) to the document identifier (url, col 11, line 5) as an encoded representation of the collaborative content, and first rendering instructions (502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26, please also see , Jscript, HTML/DHTML, col 12, lines 33-35).

Appellant argued Rivette fails to disclose "server process as claimed, with a second embedded annotation and second rendering instructions, and a third embedded annotation and third rendering instructions" (Brief, P 36). Examiner disagrees.

Rivette discloses a second embedded annotation and second rendering instructions (New set of notes, col 11, lines 20-30), and a third embedded annotation and third rendering instructions (sub-notes, col 11, lines 24-30, please also see for rendering, 502, 1020A, fig 10, col 11, lines 20-30, col 18, lines 12-26, please also see , Jscript, HTML/DHTML, col 12, lines 33-35).

It is to be noted software runs on the system or what system does will not differentiate the claims from the prior art. More specifically, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an system must be distinguished from the prior art in terms of structure rather than function alone. (MPEP 2214; In re Swineheart, 169 USPQ 226; In re Schreiber, 44

USPQ2d 1429 (Fed. Cir. 1997)). And document stored in computer memory will not differentiate a claimed computer from the prior art. In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01.

For all these reasons, claims 1-14 and 16-65 are properly rejected under U.S.C. 102(e) as being anticipated by Rivette et al. Independent claims 1, 17, 23, 41, and 53 are properly rejected for the same reasons as discussed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mohammad A Siddiqi/

04/23/2008

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Patent Examiner, Art Unit 2154

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154

Conferees:

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151